

REMARKS

At the time of the Office Action dated December 27, 2005, claims 1-16 were pending and rejected in this application. Claims 5, 7, and 16 have been have been amended to address alleged informalities noted by the Examiner. Applicant submits that the present Amendment does not generate any new matter issue.

CLAIMS 5 AND 7 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page 2 of the Office Action, the Examiner identified a perceived informality generating an antecedent basis issue. This rejection is respectfully traversed.

Applicant notes that claims 5 and 7 have been amended to address antecedent basis issues. As such, Applicant respectfully solicits withdrawal of the imposed rejection of claims 5 and 7.

With regard to claim 7, the Examiner also asserted that "the term [CSS] is indefinite because the specification does not clearly define the term." Applicant strongly disagrees. The acronym CSS has been associated with the phrase "cascading style sheet," in three places within the specification: the 2nd full paragraph on page 5, the 1st full paragraph on page 11, and in claim 7 itself. Moreover, although a common meaning of the acronym CSS is cascading style sheet, a search of the internet yields many other different possible definitions for the acronym CSS, including content style sheet, as disclosed through Applicant's specification.

For the Examiner to interpret the acronym CSS as meaning "Cascading Style Sheet" is to blatantly disregard to meaning of attributed to that acronym in Applicant's specification. Furthermore, in so doing, the Examiner is completely ignoring that the phrase "content style sheet" immediately precedes the acronym CSS in claim 7. In examining claim 7 "based upon a possible acceptable meaning of CSS ('Cascading Style Sheet')," did the Examiner ignore the phrase "content style sheet" recited in claim 7?

Applicant's position is that one having ordinary skill in the art would have no difficulty understanding the scope of claim 7, particularly when reasonably interpreted in light of the written description of the specification.¹ Thus, the imposed rejection of claims 5 and 7 under the second paragraph of 35 U.S.C. § 112 has been overcome and, hence, Applicant respectfully solicits withdrawal thereof.

**CLAIMS 1-2, 10-11, AND 13 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING
ANTICIPATED BY GAJEWSKA ET AL., U.S. PATENT PUBLICATION NO. 2002/0175951
(HEREINAFTER GAJEWSKA)**

On pages 3-6 of the Office Action, the Examiner asserted that Gajewska discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

At the outset, Applicant notes that the Examiner rejected claims 10 and 11, each depending upon claims 9, 8, and 6, without rejecting claims 6, 8, and 9. Since claims 10 and 11

¹ In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

depend upon claims 9, 8, and 6 (which, by definition, requires that claims 10 and 11 include all the limitations recited in claims 6, 8, and 9), the Examiner cannot assert that claims 10 and 11 are identically disclosed by Gajewska without asserting that claims 6, 8, and 9 are also identically disclosed by Gajewska. The rejection of claim 13 also suffers from the same problem (claim 13 depends from claim 12). Applicant proceeds on the basis that the Examiner intended to include claims 10-11 and 13 within the rejection under 35 U.S.C. § 103 for obviousness based upon Gajewska in view of Hamada.

Also, Applicant recognizes that the claimed invention and Gajewska both address the issue of focus change. This commonality notwithstanding, how the claimed invention and Gajewska address this issue is different. The Examiner, however, appears to be under the mistaken belief that Gajewska disclosing focus change is sufficient to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.² As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.³ This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in

² In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

³ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra*.

Gajewska being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).⁴

Despite this requirement, the Examiner's statement of the rejection simply consists of the Examiner reproducing portions of Gajewska without asserting which of the recited features are identically disclosed by these portions. The importance of the specificity requirement of 37 C.F.R. § 1.104(c) is evident in M.P.E.P. § 706.07, which states:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

A clear issue, however, cannot be developed between Applicant and the Examiner where the basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis" provides little insight as to (i) how the Examiner is interpreting the elements of the claims and (ii) what features within Gajewska the Examiner believes identically discloses the specific elements (and interactions between elements) recited in the claims.

By failing to specifically identify those features recited in the claims that are allegedly being disclosed by Gajewska in the rejection, the Examiner has essentially forced Applicant to engage in mind reading and/or guessing to determine how the Examiner is interpreting the elements of the claims and what specific features within Gajewska the Examiner believes identically disclose the specific features of the claimed invention. Applicant also notes that any

⁴ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

continuing disagreement between Applicant and the Examiner as to whether or not a particular claimed feature is disclosed by Gajewska is a direct result of the ambiguity in the Examiner's statement of the rejection.

Claim 1

Independent claim 1 recites "assigning an unfocused style" and "assigning a focused style" to certain portlets. The Examiner, however, has failed to indicate where these features are identically disclosed by Gajewska. A textual search of Gajewska fails to yield any mention of the term "style." Moreover, an search of Gajewska fails to yield any mention of assigning a style to a portlet. Therefore, Gajewska fails to explicitly identically disclose the claimed invention, as recited in claim 1. Also, a reliance upon the doctrine of inherency to disclose these features would be misplaced.

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.⁵ To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.⁶ The Examiner did not discharge that burden of indicating where a teaching regarding the necessity of assigning an unfocused style or focused style appears in the prior art. Thus, the Examiner has not established

⁵ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

⁶ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

that this limitation is inherently disclosed by Gajewska. In this regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof." Therefore, for the reasons stated above, Applicant respectfully solicits withdrawal of the imposed rejection of claims 1 and 2 under 35 U.S.C. § 102 for anticipation based upon Gajewska.

**CLAIMS 3-9, 12, AND 14-16 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON GAJEWSKA IN VIEW OF HAMADA, U.S. PATENT PUBLICATION NO. 2004/0010755**

On pages 7-18 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Gajewska in view of Hamada to arrive at the claimed invention. This rejection is respectfully traversed.

As noted above, Applicant proceeds on the basis that the Examiner intended to reject claims 10-11 and 13 under 35 U.S.C. § 103 for obviousness based upon Gajewska in view of Hamada.

Claim 6

Regarding independent claim 6, Applicant notes that the main teachings in Hamada relied upon by the Examiner are the use of a style sheet D13 to format a partial document (i.e., the Examiner's asserted portlet). However, not only is Hamada is completely silent as to "a focused style sheet" and "an unfocused style sheet," which the Examiner already admits is not disclosed by Gajewska, Hamada is also completely silent as to focus change. Therefore, even if one having ordinary skill in the art were motivated to modify Gajewska in view of Hamada, the claimed invention would not result.

With regard to the requisite motivation to combine, reference is made to M.P.E.P. § 2144, which is reproduced, in part, below:

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. [cites omitted] The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination.

Therefore, the motivation (i.e., rationale) to combine can be found either (i) expressly or impliedly in the prior art, (ii) based on established scientific principles, (iii) legal precedent, or (iv) knowledge generally available to one of ordinary skill in the art.

With regard to these various sources for the motivation to combine, the Examiner cannot argue that the motivation to combine is expressly or impliedly found in the prior art since the Examiner has failed to point out where in the applied prior art this motivation can be expressly or impliedly found. As apparent from the Examiner's statement of the rejection, the Examiner is not asserting "established scientific principles" as a source for the motivation to combine.⁷ It is also apparent from the rejection that the Examiner is not asserting "legal precedent."⁸

As noted in the second paragraph in M.P.E.P. § 2144.03, Federal Circuit decisions have addressed when it is appropriate "to rely on common knowledge in making a rejection." As

⁷ If the Examiner relies on scientific theory, the Examiner is required to provide evidentiary support for the existence and meaning of the theory. *In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979).

⁸ The Examiner may only use the rationale used by a Court in a prior legal decision, if the facts in the legal decision are sufficiently similar to those in the application under examination. M.P.E.P. § 2144.04.

discussed throughout this section of the M.P.E.P., reliance on common knowledge should be limited and rare when an application is under final rejection. M.P.E.P. § 2144.03(A) also states:

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.") ... As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. Id. at 1385, 59 USPQ2d at 1697. See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)

The Federal Circuit decision of In re Lee,⁹ which is briefly discussed in M.P.E.P. § 2144.03 provides an illuminating discussion on the burden placed on an Examiner to establish objective factual finds of record for the requisite motivation to combine. This case was an appeal from a decision of the Board of Patent Appeals (hereinafter the Board) in which Lee argued that the Examiner failed to provide a source of a teaching, suggestion, or motivation to combine the applied prior art to arrive at the claimed invention. The Board responded to Lee's argument by ruling "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference."

The Federal Circuit overturned the Board's decision "for failure to meet the adjudicative standards for review under the Administrative Procedure Act." The Court stated:

Judicial review of a Board decision denying an application for patent is thus founded on the obligation of the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusions. (emphasis added)

⁹ 277 F.3d 1338 (Fed. Cir. 2002).

The Court then focused on the failure by the Patent and Trademark Office (PTO) to provide a factual basis for the motivation to combine the applied prior art. For example, the Court stated:

"The factual inquiry whether to combine references must be thorough and searching." ... It must be based on objective evidence of record. This precedent has been reinforced in myriad of decisions, and cannot be dispensed with.

On the basis of several previous decisions that call for specificity and factual support in the PTO's rejections, the Court attacked the Examiner's conclusory statements regarding the obviousness of the proposed combination as being factually unsupported. With regard to the Board decision, the Court stated:

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

The Court also stated that the PTO is "not free to refuse to follow circuit precedent" and "cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims."

On page 8 of the Office Action, the Examiner set forth the following rationale to support the motivation to combine Gajewska and Hamada:

Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to define focused and unfocused attributes/instructions for portlets, within style sheets. The motivation for doing so would have been the benefit of being able to conveniently designate a portlet as being focused or unfocused simply by assigning the portlet the appropriate sheet.

The Examiner's asserted motivation to combine, which is "to conveniently designate a portlet as being focused or unfocused simply by assigning the portlet the appropriate sheet," and lack of factual support thereof comports very closely to the analysis disapproved by the Federal Circuit in In re Lee. As such, the Examiner's failure to provide factual support for a teaching,

suggestion, or motivation to combine the applied prior art constitutes legal error. It should, therefore, be apparent that the Examiner did not discharge the initial burden of establishing a prima facie case of obviousness under 35 U.S.C. § 103.

Claim 12

Independent claim 12 is substantially similar to independent claim 1 with a difference being that claim 1 recites unfocused style and focused style whereas claim 12 recites unfocused style sheet and focused style sheet. Applicant, therefore, incorporates herein the arguments previously presented with regard to claim 1. Furthermore, Applicant incorporates herein the arguments previously presented with regard to claim 6 and how the Examiner has (i) failed to factually establish that Hamada teaches the claimed unfocused style sheet and focused style sheet and (ii) establish a proper motivation to modify Gajewska in view of Hamada.

Claim 3

Claim 3 recites that the "step of performing said re-assigning and re-rendering steps through a script embedded in said portal," and in the statement of the rejection the Examiner cited paragraph [0012] and feature D13 in Fig. 4 of Hamada. However, as illustrated in Fig. 4 of Hamada the style sheet D13 is part of the page part D1. Therefore, presuming that the Examiner intends to assert that the style sheet D13 of Hamada performs the claimed "re-assigning and re-rendering steps through a script," then the style sheet D13 of Hamada fails to teach or suggest this feature.

The above-identified processes are performed "though a script embedded in said portal."
However, the Examiner has already asserted that partial document (partial page) D1 corresponds to the claimed portlet, but the claimed portal is different than the claimed portlets. Therefore, whereas claims 3 recites that the script is embedded in the portal, Hamada teaches that the style sheet D13 is found within the portlet D1. Therefore, Hamada cannot teach the limitations for which the Examiner is relying on Hamada to teach.

Claim 4

Dependent claim 4 recites the following limitations:

- defining said portal in a markup language document;
- defining a divisible section of said markup language document for each of said focused and unfocused portlets; and,
- performing said assigning and further assigning steps by specifying a class attribute for each of said focused and unfocused portlets, said class attribute corresponding to a style sheet selected from the group consisting of a focused style sheet and an unfocused style sheet.

Since the Examiner did not assert that Gajewska teaches any of these limitations, Applicant proceeds on the basis that the Examiner is asserting that Hamada teaches these limitations.

However, all the Examiner asserts on page 11 of the Office Action is that "his invention [] can be applied to a general structured document such as ... an XML document" and that:

it would have been obvious to a person of ordinary skill in the art that an XML document (markup language document) are typically divided in a plurality of sub-contents (portlets). The motivation for doing so would have been for the benefit of each portlet functioning independent of each other despite having similar content.

Notwithstanding that the Examiner has failed to establish that Hamada teaches all the limitations recited in claim 4 the Examiner's asserted motivation to combine again lacks factual support in the applied prior art.

Applicant, therefore, respectfully submits that the imposed rejection of claims 3-16 under 35 U.S.C. § 103 for obviousness based upon Gajewska in view Hamada is not factually or legally viable and, hence, solicits withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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